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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,967	05/29/2001	Michael Gerard Gallagher	MP/W-21927/A/AC 536	7387
324	7590	11/17/2003	EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION			HRUSKOCI, PETER A	
PATENT DEPARTMENT			ART UNIT	
540 WHITE PLAINS RD			PAPER NUMBER	
P O BOX 2005			1724	
TARRYTOWN, NY 10591-9005			DATE MAILED: 11/17/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/866,967	GALLAGHER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Peter A. Hruskoci	1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 September 2003 and 03 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5-7, 10-12 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 10-12 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

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Claims 16-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 16 "particulate treatment chemical" appears to be inconsistent with the "solid grade polymer particles" of claim 1. Claims 17 and 18 depend from claim 16.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-7, and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pearson in view of Quinn et al. and Pickering et al. Pearson disclose (see col. 3 line 10 through col. 9 line 13) a process for combining polymeric particles with dispersed particulate solids substantially as claimed. The claims differ from Pearson by reciting that the particles are added as solid grade particles, and have a specific intrinsic viscosity. Quinn et al. disclose (see col. 2 line 23 through col. 5 line 40) that it is known in the art to add solid grade particles to an aqueous liquid containing solids prior to the pumping of the liquid, to aid in separation of the solids. Pickering et al. disclose (see col. 6 line 9 through col. 8 line 45) that it is known in the art to utilize polymer flocculants having recited intrinsic viscosity to aid in dewatering mineral suspensions pumped through a flow line. It would have been obvious to one skilled in the art to modify the process of Pearson by utilizing solid grade polymeric particles having the recited intrinsic viscosity in view of the teachings of Quinn et al. and Pickering et al., to aid in dewatering the aqueous fluid. The specific particle size of the polymers and dispersed solids, would have been an obvious matter of process optimization to one skilled in the art, depending

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on the specific aqueous fluid treated and results desired, absent a sufficient showing of unexpected results.

Claim 1 properly written to include the addition of the solid grade polymer particles to the mixing chamber as recited in claim 16, would be allowable.

Applicants argues that the key attributes of the instant invention are now a) pumpability; b) addition during or prior to pumping; and c) the selection of a specific "solid grade polymer particles", which clearly distinguish from Pearson's water soluble polymeric emulsions. Applicants are directed to col. 8 lines 38-49 of Pearson, which teaches the use of a centrifugal pump to mix the polymer with the dispersion. It is submitted that Quinn et al. as applied above was used to teach that it is known in the art to add solid grade particles to an aqueous liquid containing solids prior to the pumping of the liquid, to aid in separation of the solids.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter A. Hruskoci whose telephone number is 703-308-3839. The examiner can normally be reached on Monday through Friday from 6:30AM-4:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 703-308-1261. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Peter A. Hruskoci  
Primary Examiner  
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11/12/03